

## **REMARKS**

In the Office Action, the Examiner rejected claims 1-50. Applicant respectfully asserts that the pending claims are patentable and in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and allowance of the instant claims in light of the following remarks.

### **Finality of Office Action**

In the Office Action, the Examiner finally rejected claims 1-50. Applicant, however, respectfully disagrees with the Examiner's holding of *final* rejection with respect to the instant claims. In summary, Applicant respectfully asserts that the Examiner's holding of final rejection is premature, because Applicant lacked a translated copy of a foreign reference (i.e., DE/29,616,175) until the present Office Action.

The M.P.E.P. states that “[b]efore final rejection is in order a clear issue should be developed between the examiner and applicant.” M.P.E.P. § 706.07. The M.P.E.P. further states “[t]o bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claims should be thoroughly searched in the first action and the *references fully applied.*” *See id.* (Emphasis added).

In the instant case, the Examiner finally rejected the claims based upon a foreign reference, namely the DE 29/616,175 reference (‘175 reference). Although the Examiner presented and cited this reference in a previous Office Action (Paper No. 10), the Examiner

failed to provide a translation of this reference for Applicant's review. Accordingly, in a previous Response to Office Action (i.e., Amendment and Response to Office Action Mailed June 11, 2003), Applicant requested that the Examiner provide a translation of the '175 reference in accordance with M.P.E.P. § 706.02. Applicant thanks the Examiner for providing a translation of the '175 reference in response to this request. However, Applicant only received the translation of the '175 reference with the present Office Action (Office Action Dated November 4, 2003). Thus, Applicant respectfully asserts that the '175 reference was only *fully applied* in the present Office Action. The Examiner's previous rejections were incomplete and unclear due to the missing translation. As such, Applicant respectfully asserts that the Examiner has not afforded Applicant an appropriate opportunity to review and respond to the '175 reference prior to final rejection of the instant claims.

Thus, in accordance with M.P.E.P. § 706.07(d), Applicant respectfully requests that the Examiner withdraw the holding of final rejection regarding the instant claims.

### **Rejections Under 35 U.S.C. § 102**

In the Office Action, the Examiner rejected claims 1-18, 20-32, 34-42, and 44-50 under 35 U.S.C. §102(b) as being anticipated by the '175 reference. Applicant respectfully transverses the rejection. In summary, Applicant respectfully asserts that the '175 reference fails to disclose all of the features recited in the instant claims.

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985).

For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Indeed, “[t]he identical invention must be shown in as complete detail as is contained in the...claim.” *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

According to one embodiment, the present invention provides *a personal computer* including a housing configured for a display. The housing of the personal computer includes a plurality of computing components that are disposed within the housing. Additionally, the present invention provides a wall mount structure configured to mount the housing on a substantially vertical surface. With this in mind, Applicant respectfully asserts that the cited ‘175 reference fails to disclose all of the features recited in the instant claims.

However, prior to addressing the specifics of the instant claims, Applicant addresses the Examiner’s assertions regarding the recitation “personal computer” with respect to the instant claims. In the Office Action, the Examiner provided a definition for the recitation “personal computer.” Specifically, the Examiner cited the IEEE 100 Authoritative Dictionary of IEEE Standard Terms, which states:

personal computer (1)...A system, containing a host and a limited number of peripherals designed *to be used in the home or in small offices*, that *enables individuals to perform a variety of computing or word-processing functions or both...*

(2) A single-user microcomputer *designed for personally controllable applications.*

See Office Action Mailed November 4, 2003; *see also* IEEE 100 The Authoritative Dictionary of IEEE Standard Terms 812 (7th ed.). (Emphasis added). As demonstrated below, Applicant respectfully asserts that the '175 reference does not disclose a personal computer as recited in the instant claims and as defined by the Examiner. Even if the Examiner's definition of a personal computer is accepted, the '175 reference still fails to disclose a personal computer.

### **Independent Claim 1 and The Claims Depending Therefrom**

Independent claim 1 recites:

*a personal computer* including a housing configured for display, the housing having a plurality of computing components disposed therein; and

a wall mount structure configured to mount the housing on a substantially vertical surface.

(Emphasis added). Applicant respectfully asserts that the '175 reference fails to disclose all of these features.

For example, the '175 reference fails to disclose any semblance of a *personal computer*. Rather, the translation of the cited '175 reference as provided by the Examiner states that "*in contrast to the current-notebook computers*, with which the main emphasis points are the production, change, calculation and managing of data, the device according to the invention should serve *solely for the reproduction of data systems*." Translation of the '175 Reference, page 3, lines 3-7. (Emphasis added). Indeed, the electronic display device of the '175 reference requires the use of an *independent computer system* to input data into and control the electronic

display device. *See* Translation of the ‘175 Reference, page 1, lines 9-13. The display device of the ‘175 reference is incapable of manipulating data and receiving controls. Furthermore, the cited reference states that preferred applications of the electronic display device are as “an advertising means or as an item of furniture (‘electronic wall picture’).” *See id.*, page 1.

With the foregoing in mind, Applicant respectfully asserts that the device of the ‘175 fails to meet the definition of a personal computer, even as provided by the Examiner. For example, the *sole* purpose of the advertising display device of the ‘175 reference is in stark contrast to a personal computer that “enables individuals to perform a *variety of computing or word-processing functions or both*,” as defined by the Examiner. *See* IEEE 100 The Authoritative Dictionary of IEEE Standard Terms p. 812 (7th ed.). Moreover, the device of the ‘175 reference *requires* a separate computer to perform any semblance of operation or control. *See* Translation of the ‘175 Reference, page 1, lines 9-13. This too is in stark contrast to a personal computer that, as defined by the Examiner, is a “single-user microcomputer *designed for personally controllable* applications.” *See id.* Indeed, as quoted above, the ‘175 reference explicitly states that the disclosed electronic display device is “*in contrast to the current-notebook computers.*” *See* Translation of the ‘175 Reference, page 3, lines 3-4. Thus, even if the display device of the ‘175 reference may or may not include components found in a notebook computer, these components are *explicitly* configured to *not* form a person computer. Applicant respectfully asserts that the Examiner must not attribute teachings to a reference that are missing. In the instant case, the cited ‘175 reference clearly and explicitly states that the disclosed electronic display device is “in contrast to the current-notebook computers” and “should serve solely for the reproduction of data systems.” *See* Translation of the ‘175 Reference, page 3, lines 3-7.

Moreover, the ‘175 reference touts the cost savings of the disclosed device over “notebook-computer systems.” *See id.*, page 3, lines 14-17. Thus, Applicant respectfully asserts that the Examiner’s contention that the display device of the ‘175 reference is a personal computer specifically adapted for use as an electronic display device is unsupported by the disclosure of the ‘175 reference. Accordingly, a ‘175 reference is absolutely devoid of any semblance of a personal computer, even in view of the Examiner’s definition of a personal computer.

Therefore, Applicant respectfully asserts that the ‘175 reference does not anticipate independent claim 1 and its respective dependent claims 2-18 and 20. Accordingly, Applicant respectfully requests reconsideration and allowance of the instant claims.

#### **Independent Claim 21 and the Claims Depending Therefrom**

Independent claim 21 recites:

*a personal computer*, comprising:

a housing comprising a display, a plurality of computing devices  
and an upright surface mount configured to mount the housing to a  
substantially upright surface

(Emphasis added). Applicant respectfully asserts that the ‘175 reference does not disclose all of these features.

For example, the ‘175 reference fails to disclose a *personal computer*, even as defined by the Examiner. As discussed above, the ‘175 reference discloses an electronic display device that serves a *single* function: displaying data provided by a *independent* computer system. *See* Translation of the ‘175 Reference, page 1. Indeed, the ‘175 reference explicitly states that the

disclosed display device is “in contrast to current-notebook computers.” *See id.*, page 3, line 3. Accordingly, Applicant respectfully asserts that the ‘175 reference fails to disclose all of the recited features of the instant claim.

Therefore, Applicant respectfully asserts that the cited ‘175 reference does not anticipate independent claim 21 and its respective dependent claims 22-32 and 34-36. Accordingly, Applicant respectfully requests reconsideration and allowance of the instant claims.

**Independent Claim 37 and the Claims Depending Therefrom**

Independent claim 37 recites,

a *personal computer* having a computer enclosure, comprising:  
a display screen;  
a plurality of electronics; and  
a surface mount configured to mount the computer enclosure to a wall

(Emphasis added). Applicant respectfully asserts that the cited ‘175 reference does not disclose all of these recited features.

As discussed above, the ‘175 reference does not disclose a personal computer, even as defined by the Examiner. Instead of a personal computer, the ‘175 reference merely discloses a display device that requires an *independent computer* for receiving data for display. Accordingly, the ‘175 reference does not disclose all of the features recited by the instant claim.

Therefore, Applicant respectfully asserts that the cited '175 reference does not anticipate independent claim 37 and its respective dependent claims 38-42, 44 and 45. Accordingly, Applicant respectfully requests reconsideration and allowance of the instant claims.

**Independent Claim 46 and the Claims Depending Therefrom**

Independent claim 46 recites,

integrating a display assembly with a plurality of  
computing components in a panel enclosure of a *personal  
computer*; and

coupling a vertical surface mount to the panel enclosure.

(Emphasis added). Applicant respectfully asserts that the cited '175 reference fails to disclose all of these recited features.

As discussed above, the '175 reference does not disclose a personal computer, even as defined by the Examiner. Rather, the '175 reference discloses an electronic display device that is *explicitly* described as *not being a computer*. See Translation of the '175 Reference, page 3, lines 3-4. Accordingly, Applicant respectfully asserts that the cited '175 reference does not disclose all of the features recited by the instant claims.

Therefore, Applicant respectfully asserts that the '175 reference fails to anticipate independent claim 46 and its respective dependent claims 47-50. Accordingly, Applicant respectfully requests reconsideration and allowance of the instant claims.



### **Rejections Under 35 U.S.C. § 103**

In the Office Action, the Examiner rejected claims 1-50 under 35 U.S.C. § 103(a) as being unpatentable and obvious in light of various reference combinations. Applicant, however, respectfully traverses the rejections. In light of the following remarks, reconsideration and allowance of the instant claims are respectfully requested.

### **First Rejection Under Section 103**

In the Office Action, the Examiner rejected dependent claims 19, 33, and 43 under 35 U.S.C. §103(a) as being unpatentable over the '175 reference as applied to independent claims 1, 21, and 37 respectively, in view of the Lochridge reference (U.S. Pat. No. 5,610,798). Applicant respectfully traverses the rejection.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). To establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

As discussed above, the '175 reference does not disclose all of the features recited by independent claims 1, 21, or 37 from which claims 19, 33, and 43 depend. Additionally, there is no reason to believe that the Lochridge reference obviates the deficiencies of the '175 reference as discussed above. Accordingly, Applicant respectfully asserts that dependent claims 13, 33,

and 43 are patentable over the references cited above, because the cited references, taken alone or in combination, fail to disclose all of the recited features of the instant claims. Accordingly, Applicants respectfully assert that the cited references fail to render the instant claims obvious.

Therefore, Applicant respectfully asserts that claims 19, 33 and 43 are not obvious in view of the cited references, taken alone or in combination. In light of the foregoing remarks, reconsideration and allowance of the instant claims are respectfully requested.

### **Second Rejection Under Section 103**

In the Office Action, the Examiner rejected claims 1-50 under 35 U.S.C. §103(a) as being unpatentable over the Goodrich et al. reference (U.S. Pat. No. 5,375,076) in view of the '175 reference. Applicant respectfully traverses the rejection. The cited reference combination lacks the requisite suggestion or motivation for combination.

As stated above, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). Indeed, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). In other words, the artisan, viewing only the

collective teachings of the references, must find it obvious to selectively pick and choose various elements and/or concepts from the cited references to arrive at the claimed invention. *See Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I 1985). Moreover, the Federal Circuit has warned that the Examiner must not, “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)). Avoiding hindsight reconstruction is especially important regarding less technologically complex inventions, where the very ease with which the invention can be understood may prompt one employ such hindsight. *See id.*

As discussed above, the ‘175 reference merely discloses an *advertising display device*, and not a *personal computer*, as recited in each of the above listed independent claims and as defined by the Examiner. The Examiner apparently believes that the Goodrich reference cures this deficiency. The Goodrich reference discloses a “*portable* computer system that functions as a *notepad* computer and includes provisions for receiving and storing a keyboard to operate as a *notebook* computer.” Goodrich, column 1, lines 7-11. Thus, a primary thrust of the Goodrich reference is the *portability* of the notepad computer disclosed therein. This portability is wholly antithetical to the wall mounted display device disclosed by the ‘175 reference. More specifically, mounting the Goodrich notebook computer to a wall completely vitiates the portable nature of the notebook computer system of Goodrich. If a proposed modification or combination of the prior art changes the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *See In re Ratti*, 123 U.S.P.Q. 349 (C.C.P.A. 1959). Clearly, in the instant case, mounting a portable

computer to a wall changes the portable principle of operation of a notebook or portable computer. Indeed, a skilled artisan would not find the motivation in combining a portable notebook computer with a wall-mounted electronic device. Thus, the cited references lack the necessary motivation for combination.

Therefore, Applicant respectfully asserts that the Examiner is, at best, using the disclosure of the instant application to find motivation in combining the cited references. As discussed above, such hindsight reconstruction is not permitted. Accordingly, Applicant respectfully asserts that the cited references, taken alone or in combination, lack the disclosure and motivation for combination, and, as such, fail to render obvious the instant claims. Therefore, Applicant respectfully asserts that claims 1-50 are patentable over the Examiner's cited reference combination. In light of the foregoing remarks, Applicant respectfully requests reconsideration and allowance of the instant claims.

#### **Patentable Weight of Functional Language**

Prior to concluding, Applicant addresses the Examiner's interpretation of claim construction below. In the Office Action, more particularly in reference to the rejection of dependent claims 35 and 40 under the '175 – Goodrich reference combination, the Examiner stated:

Regarding the functional recitation "wall mountable", please note that it is narrative in form, since any thing [sic] can be mounted to the wall. In order to be given a proper patentable weight, a

functional recitation must be expressed as a “means” for performing the specified function (i.e. a specific structure which would allow the device to be readily mounted to the wall), as set forth in 35 USC § 112, 6th paragraph, or must be supported by recitation in the claims of sufficient structure to warrant the presence of functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Office Action Mailed November 4, 2003, p. 6. (Emphasis in original). Applicant does not agree with the Examiner’s interpretation of long standing precedent and black-letter law. Moreover, Applicant objects to the Examiner’s failure to consider and address the inapplicability of the *In re Fuller* decision to the instant claims.

As stated in previous Responses, the rules of claim interpretation suggested by the Examiner are incorrect for several reasons. First, the functional limitations recited in the claims are to be given patentable weight. Secondly, to be given patentable weight, a functional recitation *does not* have to be expressed as a “means” for performing the specified function. Thirdly, a functional limitation *does not* have to “be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language.”

First, the Examiner’s assertion that “wall mountable” is a functional recitation, and, as such, is not given patentable weight because it is “narrative in form” was improper. Applicant respectfully asserts that the Examiner has failed to define “narrative in form” and has also failed to provide the *legal basis* for not giving the allegedly functional limitation patentable weight because of such “narrative” status..

Although the Examiner cited the *In re Fuller* decision (a case decided in 1929), a review of this case fails to show support for the Examiner's position. The *In re Fuller* case revolved around an invention that "consists of a *process* for constructing a woolen fabric for clothing which will have all the advantages of the ordinary woolen fabric yet will not become unduly shiny or glossy as a result of friction and wear." *In re Fuller*, 35 F.2d 62 (C.C.P.A. 1929). (Emphasis added). The focus of the court in *In re Fuller* was the lack of *written description* and a failure to adequately support the claimed invention, which related to a *process*. The only statement Applicant found in this case regarding functional language is a cursory statement that "[i]t [the rejected claim] is also *functional*, describing a result only, and not a *process*, and can, therefore, have no standing here." *Id.* (Emphasis added). In view of the foregoing passage, the *In re Fuller* case appears to be limited to process claims describing a result and, as such, the case does not provide legal basis for ignoring the recitation of "wall mountable," as set forth in the instant claims. Moreover, the *In re Fuller* case does not require that functional language necessarily invokes 35 U.S.C. § 112, sixth paragraph. Indeed, *In re Fuller* case was decided almost twenty four years prior to the enactment of Section 112.

The only other support the Examiner provided for his assertion regarding the patentable weight of "wall mountable" was his statement that "it [the claim recitation] is narrative in form, since any thing [sic] can be mounted to the wall." Applicant respectfully asserts that such an interpretation is unreasonable and contrary to what one of ordinary skill in the art would believe. *Cf.* M.P.E.P. § 2173.05(g) (stating that "a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used"). Clearly, the term wall

mountable in combination with the specific structures recited in the instant claims would fairly convey wall-mounting mechanisms for the respective structures. Accordingly, the recitation “wall mountable” should undoubtedly be given patentable weight.

Secondly, to be given patentable weight, a functional recitation *does not* have to be expressed as a “means” for performing the specified function, particularly where the claims are not intended to fall within the scope of 35 U.S.C § 112, sixth paragraph. The instant claims are not intended to be “means for” claims and, as such, Section 112, sixth paragraph, is inapplicable to the instant claims. Indeed, the Examiner’s citation to the *Donaldson* case, a case related to the interpretation of means-plus-function claims, is inapplicable to the instant claims, which are not means-plus-function claims.

Thirdly, a functional limitation *does not* have to “be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language,” as asserted by the Examiner. The M.P.E.P. § 2173.05(g) specifically states that:

There is *nothing inherently wrong* with defining some part of an invention in *functional terms*.... A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.... A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is recited by the element, ingredient or step.

M.P.E.P. § 2173.05(g). (Emphasis added). Indeed, courts have recognized that there may be a practical *necessity* for the use of functional language. *See In re Swinehart*, 439 F.2d 210, 213, 169 U.S.P.Q. 226, 228-29 (C.C.P.A. 1971). (Emphasis added). Under the view today,

functional language in a claim is not objectionable *per se* so long as it avoids problems of undue breadth and vagueness. See Donald S. Chisim, CHISIM ON PATENTS § 8.04, p. 8-99 (citing *In re Swineheart*, 439 F.2d 210, 169 U.S.P.Q. 226). What is important is *not* simply that a recitation is defined in terms of what it does, but that the recitation has a reasonably well-understood meaning in the art. *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583, 39 U.S.P.Q.2d 1783, 1786 (Fed. Cir. 1996) (further stating that “many devices take their names from the functions they perform.... [and that] ‘Detent’ (or its equivalent ‘detent mechanism’) is just such a term”). In other words, so long as a recitation is readily understood by those in the pertinent art (i.e. it is not vague and unduly broad), it must be given patentable weight.

As discussed above, the recitation “wall mountable” is a term that would be readily understood and appreciated by one of ordinary skill in the art of computers. For the reasons set forth above, the recitation “wall mountable” must be given patentable weight.



**Conclusion**

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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